

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte BRUCE HA, STEVEN A. GLAZA  
and CHERYL M. BIANCHI

Appeal No. 2005-0204  
Application No. 09/393,527



ON BRIEF

Before HAIRSTON, KRATZ and DELMENDO, Administrative Patent Judges.  
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 2, 4-6 and 9-15, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to a hybrid optical recording disc with copy protection and a method of providing such a disc. An understanding of the invention can be derived from a reading of exemplary claims 2, 5 and 9, which are reproduced below.

2. A hybrid optical recording disc with copy protection for use in a computer, the disc having a

substrate and a recording layer disposed over the substrate, the substrate having a mastered read-only memory (ROM) area and which includes addressing tracks dedicated to contain disc addressing data which govern read and record processes to and from a computer, and program tracks dedicated to contain computer software programs, and the substrate having a recordable area for recording therein data generated by a computer user and for reading such recorded data from the recordable area to a computer, comprising:

a) the addressing tracks of the ROM area include at least one disc identifier sub-code track containing disc identifier data embedded therein such that the disc identifier data will authenticate the installed disc addressing data and computer software programs for operation in the computer from the hybrid optical recording disc but will not be transferred, thereby providing protection against copying the disc;

b) the program tracks of the ROM area include at least one program identifier track containing program identifier data embedded therein which identify the computer software programs; and

c) the recordable area includes at least one software identifier track containing software identifier data recorded therein of the computer software programs which are included in the program tracks of the ROM area of the hybrid optical recording disc.

5. A method of providing a hybrid optical recording disc with copy protection for use in a computer, comprising the steps of:

a) mastering a read-only memory (ROM) area and a recordable area on a disc substrate so that the ROM area includes addressing tracks and program tracks, the addressing tracks including at least one disc identifier sub-code track for embedding therein authenticating disc identifier data which will not be transferred from the computer when installing the disc in the computer, thereby providing protection against copying the disc, the program tracks of the ROM area including at least one program identifier track

containing program identifier data embedded therein which identify computer software programs contained in the ROM program tracks;

b) coating an optical recording layer over the mastered disc substrate; and

c) recording in a designed software identifier track of the recordable area a software identifier, the software identifier recording step being implemented in correspondence with the software programs included in the program tracks of the disc's ROM area, the software identifier also being provided to a computer user and corresponding to a hybrid optical recording disc having selected software program titles contained in the program tracks of the ROM area.

9. A hybrid optical recording disc having copy protection for use in a computer, comprising:

a) a read-only area having preformed information including at least one program and disc identifier data, the disc identifier data being adapted to authenticate a transferred program in the computer to permit the program to be operated by the computer, said the disc identifier data being identical to disc identifier data on a plurality of other discs; and

b) a recordable area including at least one software identifier track containing software identifier data recorded therein of the computer software programs which are included in the program tracks of the ROM area of the hybrid optical recording disc, said software identifier data being unique and different for each disc with the same disc identifier data.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Yamagishi	5,379,433	Jan. 03, 1995
Oshima et al. (Oshima)	5,761,301	Jun. 02, 1998
Spitzenberger et al. (Spitzenberger)	5,930,209	Jul. 27, 1999

Claims 2, 4-6 and 9-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamagishi in view of Spitzenerger and Oshima.

We refer to the brief and reply brief and to the answer for a complete exposition of the opposing viewpoints expressed by appellants and the examiner concerning the issues before us on this appeal.

OPINION

Upon careful review of the respective positions advanced by appellants and the examiner with respect to the rejection that is before us for review, we find ourselves in agreement with appellants' viewpoint in that the examiner has failed to carry the burden of establishing a prima facie case of obviousness. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1471-1472, 223 USPQ 785, 787-788 (Fed. Cir. 1984). Accordingly, we will not sustain the examiner's rejection on this record.

In a rejection under 35 U.S.C. § 103(a), it is fundamental that all elements recited in each claim must be considered and given appropriate effect by the examiner in judging the patentability of that claim against the applied prior art. See In re Geerdes, 491 F.2d 1260, 1262-63, 180 USPQ 789, 791 (CCPA

1974). Here, appealed claim 9 requires, inter alia, a hybrid optical recording disc with a read only area thereof containing disc identifier data and a recordable area containing unique software identifier data in a software track thereof. All of the other appealed claims require a disc, or a method of preparing a disc, that includes, inter alia, disc identifier data in a read only memory (ROM) area thereof, program identifier data in another ROM area thereof, and software identifier data in a recordable area thereof.

In rejecting the appealed claims, the examiner relies on the combination of the teachings of Yamagishi, Spitzerberger and Oshima.

Yamagishi is the only reference relied upon by the examiner that expressly describes an optical disc that includes ROM areas (areas that are not rewritable by a user) and random access memory (RAM) areas (user rewritable areas or user recordable areas) thereon, as required by the appealed claims. The other two applied references describe discs that do not include user rewritable areas thereon.

Yamagishi discloses a copy protected disc wherein a program and a specific or peculiar identification (ID) code are contained in different locations of the ROM area of the disc. That

peculiar ID code is compared with a predetermined ID code stored with the program and the program can be run only when those codes correspond with each other.

Spitzenberger discloses a CD-ROM optical disc that includes sector address irregularities arranged so as to prevent unauthorized copying.

Oshima is directed to an optical disc having copy prevention capability, a method of making such a disc, reproduction apparatus, and laser mark forming apparatus and methods. Oshima discloses encryption of a disc physical ID to increase copy protection and teaches that a disc ID and a software ID are transmitted to a password issuing center for providing a password via a sub secret key that may be decrypted via a sub public key at the computer user end. Alternatively a personal computer ID or drive ID of the computer drive together with a software ID may be submitted to a password center and used in generating a password. See, e.g., column 35, line 42 through column 36, line 25 of Oshima.

The examiner recognizes that Yamagishi does not disclose using a software ID that is both unique and separate from the disc ID, which software ID is located in the recordable area of the disc, as required by appealed claim 9. Moreover, the

examiner seemingly acknowledges that the teachings of Spitzenberger regarding the storage of an irregular or different address value in digital subcode data for copy protection purposes taken together with the teachings of Yamagishi concerning a system for determining the existence of coincident program and disc ID's for copy protection, even if such a combination would have been suggested to one of ordinary skill in the art, would not have resulted in a copy protected hybrid disc (or a method of making such a disc) as variously required by the appealed claims. In that regard, the examiner (answer, page 10)<sup>1</sup> takes the position that:

[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to combine the optical disc properties of Yamagishi/Spitzenberger with Oshima's use of SID's and DID's because assigning a separate identifier each to the discs and software ensures that only authorized and proper use of the software is permitted.

Moreover, as for the appealed claims that require a disc including a disc ID, program ID and software ID, the examiner (answer, page 16) further asserts that:

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<sup>1</sup> Also, see pages 6, 13 and 14 of the examiner's answer for repeated statements of essentially the same position by the examiner.

[b]ecause Oshima shows a combination of three separate identification techniques to prevent illegal copying, it is an obvious modification for one of ordinary skill in the art to use the three-identification technique of Disk IDs, Software IDs, and Programmed IDs.

Finally, as for the requirement in all of the appealed claims that the software ID be included in the recordable area of the disc, the examiner (answer, page 15) maintains:

[i]t is the professional opinion of the examiner that it would be an obvious modification to one of ordinary skill in the optical medium recording arts to allow an ID to be recorded in either the recordable area or the non-recordable area without placing undue burden on the public.

That last quoted position of the examiner highlights the reversible error present in the examiner's stated rejection. This is so because the teachings from the prior art itself must appear to have suggested the claimed subject matter to one of ordinary skill in the art in order to establish a prima facie case of obviousness. See In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). The mere fact that the prior art could be modified as proposed by the examiner is not sufficient to establish a prima facie case of obviousness. See In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

Here, the examiner essentially argues for a determination of unpatentability based, at least in part, on the professional opinion of the examiner and an asserted lack of an undue burden on the public to do what appellants claim. This argument is not well taken because "'[c]ommon knowledge and common sense,' even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority." In re Lee, 277 F.3d 1338, 1345, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002).

Concerning this matter, the examiner's proposed modification of Yamagishi so as to allegedly arrive at the claimed subject matter is not based on the identification of a convincing and particularized suggestion, reason or motivation found in the applied prior art or logically reasoned from particular prior art teachings. See In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). As pointed out by appellants in the briefs, Yamagishi is the only reference relied upon by the examiner that relates to a hybrid optical disc, that is, a disc that includes both ROM and recordable areas thereon. In this regard, the examiner has not established how the other applied references taken with Yamagishi would have been instructive to one of ordinary skill in the art in locating a software ID in a recordable area of the disc of Yamagishi.

Against that background, the examiner's assertions of the obviousness of placing a software ID in a recordable area of the disc of Yamagishi appears to be based on appellants' teachings, not those of the applied references. Such use of impermissible hindsight in rejecting appellants' claims is not in accord with acceptable patent jurisprudence. See W.L. Gore & Associates v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984); In re Rothermel, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960).

On this record, we agree with appellants that the examiner has not established a prima facie case of obviousness.

CONCLUSION

The decision of the examiner to reject claims 2, 4-6 and 9-15 under 35 U.S.C. § 103(a) as being unpatentable over Yamagishi in view of Spitzemberger and Oshima is reversed.

REVERSED

KENNETH W. HAIRSTON )  
Administrative Patent Judge )  
PETER F. KRATZ ) BOARD OF PATENT  
Administrative Patent Judge APPEALS  
ROMULO H. DELMENDO ) AND  
Administrative Patent Judge INTERFERENCES  
Romulo H. Delmendo )

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